

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Restriction/Election, and Request for New Office Action and Resetting Date for Response filed April 8, 2009

In item 3 on page 2 of the Office Action, the Examiner acknowledges Applicants' traversal of the restriction requirement on the ground that the prior art compound (CAS:108:204491) has nothing in common with the instantly claimed compounds, but the Examiner states that this is not persuasive, and that the reasons are given *infra*. It is thus Applicants' understanding that the Examiner now agrees that the CAS:108:204491 prior art compound previously cited by the Examiner in attempting to support the restriction requirement, does not in fact establish lack of a significant structural element qualifying as a special technical feature that defines a contribution over the prior art. Rather, referring to page 3 of the Office Action, the Examiner apparently now relies on the newly cited TenBrink et al. reference (US '360 corresponding to WO 03/050073 cited in Applicants' IDS of September 19, 2006) in arguing a lack of the special technical feature that defines a contribution of the present invention over the prior art. However, as will be apparent from the following remarks, the TenBrink et al. reference does not suggest the presently claimed compounds as set forth in the amended claims. Accordingly, Applicants respectfully maintain their traversal of the restriction requirement.

With regard to Applicants' Request for New Office Action filed April 8, 2009, Applicants continue to assert that the Examiner appears not to have searched/examined the elected subject matter, for the reasons set forth in the Request for New Office Action. On April 24, 2009, Applicants' attorney left a voicemail message for the Examiner inquiring about taking action on the Request for New Office Action; and on April 27, 2009 Applicants' attorney received a voicemail message from the Examiner indicating that the current Office Action includes a rejection of the elected species (Example 3A). Nevertheless, in terms of the restriction requirement, it appears that the Examiner refers,

in the current Office Action, to non-elected subject matter, as noted in the Request for New Office Action.

Amendments

Claim 1 has been amended to delete the possibility that R⁶ is a polycyclic, unsaturated hydrocarbon radical, under both options (A) and (B).

Claim 7 has been amended to exclude naphthyl from the definition of R⁶, both when the polycyclic, unsaturated hydrocarbon radical is unsubstituted, as well as when this radical is substituted. Applicants note that naphthyl is mentioned toward the bottom of page 6 of the specification as an example of the polycyclic, unsaturated hydrocarbon radical. Therefore, its exclusion from the definition of R⁶ in claim 7 does not raise the issue of new matter (MPEP 2173.05(i)).

Referring to the first full paragraph on page 9 of the Office Action, claim 8 has been deleted, and the language for treating or preventing glaucoma has been deleted from claim 12, as suggested by the Examiner, thus rendering the rejection of claims 8 and 12 under the first paragraph of 35 U.S.C. §112 moot.

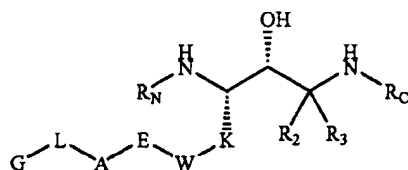
Prior Art Rejection

The rejection of claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over TenBrink et al. (WO '073/US'360) is respectfully traversed.

Initially, Applicants note that the WO '073 reference was cited in the International Search Report as the closest prior art document with regard to structure of the compounds. The PCT claims were later amended as indicated in the Solvias letter of November 9, 2005 (item 14(d) in the Transmittal Letter filed in the PTO September 19, 2006) to exclude any overlap with the WO '073 reference. In view of the amendments to claim 1 set forth above, where the possibility of R⁶ being a polycyclic, unsaturated hydrocarbon radical has been deleted from both options (A) and (B), combined with the amendments to claim 7 deleting the possibility of naphthyl for R⁶, it is Applicants' position that the presently claimed invention is clearly patentable over the TenBrink et al. reference.

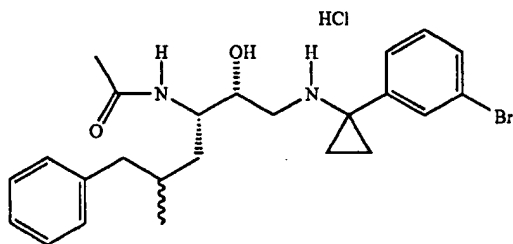
Claim 3 of WO '073 and US '360 reads:

3. A compound according to claim 1, wherein the formula is



A is defined via claim 1 as being aryl (e.g. *expressis verbis* in the description “phenyl” or “naphthyl”), cycloalkyl or heteroaryl (all defined as optionally substituted) and in Example 8 the moiety A is phenyl, while G and L are absent, and E, W, K represent an alkylene:

Example 8 of WO '073 and US '360 reads:



Thus, the comparison between “A” in WO '073 or US '360 and radical “R⁶” in the instant application is necessary.

In this regard, only compounds where “A” in the reference is either a phenyl or a naphthyl, where both can be optionally substituted e.g. by alkyl, etc. are mentioned as preferred compounds in the description of the reference.

On the other hand, in the presently claimed compounds, as set forth in amended claim 1 above, R⁶ is limited to heterocyclic radicals, thus clearly avoiding any overlap with the WO '073/US '360 reference.

With regard to amended claim 7 set forth above, since naphthyl, both unsubstituted and substituted, has been excluded from the scope of this claim, there is also no overlap between claim 7 and WO '073/US '360.

At about the middle of page 11 of the Office Action, the Examiner states that the difference between TenBrink et al. and the instant claims is that the variable W of

TenBrink et al. represents a bond or $-S-$, $-S(O)-$, while the instant claims represents a bond at the same position, and therefore the reference compounds/compositions inherently overlap with the instant invention.

However, referring to claim 3 of the TenBrink et al. reference, and comparing it with the compounds of the present invention, the following will be noted:

Reference	Instant application
a row of E; W, K must correspond to:	$X-C(R^5R^5)-CH_2-$
that A = (optionally substituted) naphthylene must correspond to:	$R^5 = \text{polycyclyl}$
and that the row of G, L must be absent	

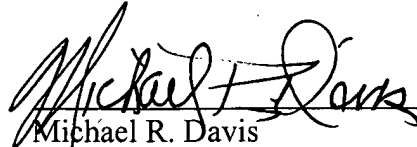
It is thus apparent that there is no overlap between the compounds claimed in the present application and the TenBrink et al. reference, nor are the presently claimed compounds suggested by the reference compounds. Accordingly, Applicants respectfully submit that the rejection based on TenBrink et al. should be withdrawn.

The Examiner has provisionally rejected claims 1-12 for obviousness-type double patenting as being unpatentable over claims 1 and 8 of Serial Nos. 11/522,316, 11/488,854 or 10/586,814. The Examiner is kindly requested to hold this double patenting rejection in abeyance, pending an indication that the claims of the present application are otherwise in condition for allowance.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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